

Application No. 09/690,512
Reply to Final Rejection dated September 3, 2003
Reply to Office Action of July 22, 2003

REMARKS

The Examiner rejected claims 1-7, 9, 11-17, 19, and 27-30 under 35 U.S.C. § 101 because the claimed method does not recite a useful, concrete and tangible result. However, 35 U.S.C. § 101 recites no requirement that the claimed invention be performed with interaction of a physical structure. “The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112.” See M.P.E.P. § 2106. The use of the expansive term “any” in section 101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35.... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented [(e.g., a “physical structure”)] where the legislative history does not indicate that Congress clearly intended such limitations.” *Id.*

The Examiner broadly construed a watermark to encompass any mark included with an advertisement. However, a digital watermark is defined as “a pattern of bits embedded into a file used to identify the source of illegal copies....” See Computer Desktop Encyclopedia, 9th ed., McGraw-Hill, pp. 249-250 (copy attached). See also, p. 4, line 21 through p. 5, line 4 of the specification. The Applicants, therefore, contend that the definition applied by the Examiner is unreasonably broad in light of the definition that would be understood by one skilled in the art.

The Examiner suggests that the claimed invention is not patentable because a watermark is an abstract idea. However, a watermark is not an idea. It is an industry recognized embedded bit pattern.

The Examiner rejected claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 112, first paragraph, as being indefinite. Specifically, the Examiner stated that the specification discusses the claimed concept but does not enable one skilled in the art to make and/or use the invention

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with respect to monitoring a watermark and accruing a credit. Figure 1 shows a block diagram of a processor-based system 10 in which “the watermark detector 60 may directly monitor the video or audio input/output channels to ensure that the channels correctly extract the advertising watermark if, and only if, the advertising is played by the digital output channel at the proper rate and for the duration of the advertising, with no extraneous masking.” See p. 5, lines 15-20. The specification goes on to explain that “alternatively, the watermark may be utilized to accrue digital coupons in return for playing the advertising.” See p. 5, lines 24-25. The provision of a watermark detector must be well known to those skilled in the art as they are used to detect digital watermarks for detecting counterfeits.

The Examiner further rejected claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 112, second paragraph, as being indefinite. However, “a rejection based on failure to [set forth the subject matter that the Applicants regard as their invention] is appropriate only where [the Applicants have] stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims.” See M.P.E.P. §§ 2171-2172. The Applicants have made no such statement. Therefore, the rejection cannot stand.

The Examiner asserts that the specification does not provide an antecedent basis for the steps included in the independently claimed method and system. However, “a claim term which has no antecedent basis in the disclosure is not necessarily indefinite.... There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity.” See M.P.E.P. § 2173.05(e). Nevertheless, the language from the claims is used in the specification as pointed out above.

The Examiner stated that the independently claimed recitation “said watermark detects watermarks” is considered indefinite because it is unclear how a symbol detects a plurality of itself. However, the recitation was merely a typographical error, and independent claim 21, the

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only claim to include such language, was amended in a previous response. The currently pending claims do not include the phrase "said watermark detects watermarks."

Independent claim 1 stands rejected under 35 U.S.C. § 102(a) as being anticipated by the Applicants' specification, under 35 U.S.C. § 102(b) as being anticipated by Filepp, et al., U.S. Pat. No. 5,347,642 (hereinafter "Filepp"), Hannah, U.S. Patent No. 5,550,595 (hereinafter "Hannah 1"), Hannah, U.S. Patent No. 5,568,192 (hereinafter "Hannah 2"), Fite, et al., U.S. Patent No. 5,557,721 (hereinafter "Fite"), Gruber, et al., U.S. Patent No. 5,717,860 (hereinafter "Gruber"), Von Kohorn, U.S. Patent No. 5,916,024, and Merriman, et al., U.S. Patent No. 5,948,061 (hereinafter "Merriman"), and under 35 U.S.C. § 102(e) as being anticipated by d'Eon, et al., U.S. Patent No. 6,006,197 (hereinafter "d'Eon"), Goodman, et al., U.S. Patent No. 6,173,271 (hereinafter "Goodman"), Rhoads, U.S. Pat. No. 6,311,214 (hereinafter "Rhoads 1"), Zhang, et al., U.S. Patent No. 6,325,420 (hereinafter "Zhang"), and Rhoads, et al., U.S. Patent No. 6,442,285 (hereinafter "Rhoads 2"). The Applicants request that the Examiner be more specific as to these rejections.

The Examiner asserted that under current Office practice a watermark may be any indicia that can identify an advertisement. As demonstrated above this definition is inconsistently broader than how the term is defined in a technical dictionary. Neither the specification, Filepp, Hannah 1, Hannah 2, Fite, Gruber, Merriman, d'Eon, nor Rhoads 1 makes any mention of monitoring a watermark included with an advertisement. These references do not teach or suggest monitoring "a pattern of bits embedded into a file." In fact, these references make no mention of an advertisement at all.

Von Kohorn fails to teach or suggest monitoring a watermark. In Von Kohorn, although an audience member's response to a task or situation may be used to determine a score for an audience member, the instructional signal itself is not monitored. The Examiner failed to address this argument in his office action.

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Goodman fails to teach or suggest associating an indication that an advertisement was played with an identifier for a particular user. In Goodman, each commercial is played by the television station including a secure identification. That identification is received, date and time confirmed, and verified. The information is sent to a billing computer. In Goodman, no mention is made of associating an indication that an advertisement was played with an identifier for a particular user.

Zhang fails to teach or suggest monitoring a watermark. In Zhang, the print control signal is merely read by the printing system. No mention is made of monitoring a watermark included with an advertisement. The Examiner failed to address this argument in his office action.

Rhoads 2 merely describes reconfiguring a watermark detector. Rhoads 2 fails to teach or suggest associating an indication that an advertisement was played with an identifier for a particular user. The Examiner failed to address this argument in his office action.

Independent claim 11 also distinguishes over the above-named references for reasons similar to those set forth with respect to independent claim 1.

Independent claim 21 stands rejected under 35 U.S.C. § 102(a) as being anticipated by the specification, under 35 U.S.C. § 102(b) as being anticipated by Filepp, Hannah 1, Hannah 2, Fite, Gruber, Von Kohorn and Merriman, and under 35 U.S.C. § 102(e) as being anticipated by d'Eon, Goodman, Rhoads 1, Zhang and Rhoads 2.

However, all of these references fail to teach or suggest a watermark detector to control operation of a media player in response to detection of a watermark. The Examiner failed to address this argument in his office action.

Independent claims 29 and 30 also distinguish over these references for reasons similar to those set forth above with respect to independent claim 21.

The Examiner rejected claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 103(a) as being obvious over the Examiner's personal experience. Specifically, the Examiner states that

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the term watermark is non-functional descriptive language that is merely information, symbols, or data items necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the Applicants. The Applicants respectfully disagree because, as stated above, a watermark has a well accepted technical definition.

The Examiner's personal experience fails to teach or suggest associating an indication that an advertisement was played with an identifier for a particular user. The Examiner asserts that a particular user identifier is a term common in the field of television viewing. However, the Examiner has failed to show how viewing a television advertisement associates an indication that the advertisement was played with an identifier for a particular user. Television viewing does not involve an identifier for a particular user. The television advertisement is merely played and viewed by those who choose to watch the advertisement. In the field of television viewing, no indication is associated with an identifier for a particular user.

Independent claim 11 also distinguishes over the Examiner's personal experience for reasons similar to those set forth with respect to independent claim 1.

Independent claim 21 calls for a watermark detector to detect a watermark included with an advertisement and to control operation of the media player in response to detection of the watermark. The Examiner's personal experience fails to teach or describe a watermark detector.

As stated above, a watermark is a well understood term not encompassed by the Examiner's personal experience. The Examiner merely points to his experience with an advertisement that does not include a pattern of embedded bits. In the absence of a watermark, the Examiner's personal experience fails to teach or suggest a watermark detector to detect a watermark included with an advertisement. Moreover, the Examiner's personal experience fails to teach or suggest a watermark detector to control operation of the media player in response to detection of a watermark.

The Examiner states that the motivation to combine the Applicants' claimed invention with the services offered by the Examiner's experience with television viewing is to allow

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greater consumer targeting capabilities through electronic mediums, while transferring information. However, "the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination." See M.P.E.P. § 2143.01 "The Fact that References can be Combined or Modified is not Sufficient to Establish *Prima Facie* Obviousness," at page 2100-124. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *Id.*

Here, the rejection amounts to a statement that it was possible to do what the Applicants did. Surely the Applicants must agree with that because, in fact, they did do it. For example, the Examiner's argument that the combination may allow greater consumer targeting capabilities through electronic mediums while transferring information may be true, but is irrelevant to the obviousness determination. As explained in the M.P.E.P., the fact that references can be combined or modified is irrelevant, absent some teaching of the desirability to do so. It is the teaching of the desirability to do so which is clearly absent in the Examiner's proposed combination. Therefore, the Examiner's argument cannot stand.

Clearly, if the "could" standard were the standard of patentability, nothing would ever be patentable because, obviously, in order to enable the invention it must be possible to make it. If it is possible to make it, there must be art that would teach the elements used to make the combination. However, something in the prior art must teach the desirability of the combination in order to render the combination obvious under our system.

Independent claims 29 and 30 also distinguish over these references for reasons similar to those set forth above with respect to independent claim 21.

The Examiner provisionally rejected claims 1-7, 9, 11-17, 19, and 21-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/896,772. The Examiner states that both applications perform substantially the same function using substantially the same means with

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substantially the same result. The Applicants respectfully disagree because the two applications do not perform substantially the same function, and they do not use substantially the same means.

Application No. 09/896,772 has nothing to do with watermarks. The two applications, therefore, do not perform substantially the same function. The two applications do not use substantially the same means because Application No. 09/896,772 uses a ping signal, which does not include an embedded pattern of bits and is not itself embedded into another signal; whereas, in the present patent application, a watermark that is included with an advertisement is monitored or detected.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested.

Respectfully submitted,

OFFICIAL

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